

## REMARKS/ARGUMENTS

After amendment, the pending claims are 1, 13-16, and 18-36. Claims 1, 27, 31, and 32 were amended to place the application in condition for allowance by amending the same to include the “easy initial tearability” aspect encompassed by the films of the invention. Support for this amendment is found in the original specification and claims as filed and specifically on page 6, line 26 through page 7, line 8 and page 13, lines 21-22. No new matter is added by these amendments.

New claims 33-36 were added to recite other embodiments of the invention. Support for these new claims is found in the original specification and claims as filed and specifically on page 6, line 26 through page 7, line 8; page 13, lines 21-22; and in the examples. No new matter is added by these new claims.

**35 USC § 103(a) Rejections**

*Claims 1, 17-25, and 27-30 are rejected under 35 USC § 103(a) over Austen et al. (US Patent No. 4,341,827);*

*Claim 26 is rejected under 35 USC § 103(a) over Austen et al. and further in view of Hatke et al. (US Patent No. 6,551,653); and*

*Claims 13-16, 31, and 32 are rejected under 35 USC § 103(a) over Austen et al. and further in view of Itakura et al. (European Patent No. 0 940 437).*

Applicants respectfully request reconsideration and withdrawal of these rejections for the following reasons.

Austen teaches away from a film that (i) is thinner than 100  $\mu\text{m}$  and (ii) is characterized by easy tearability

Austen effectively teaches away from thinner films by producing thicker films (127  $\mu\text{m}$  to 762  $\mu\text{m}$ ) which have increased strength. Applicants respectfully assert that one of skill in the art would not look to Austen to prepare thinner films, just because thinner films had been prepared by others using materials and methods inapposite to Applicants. Austen's only reference to thinner films is in the background that conventional processes are known in the art (col. 2, lines 61-66) that produce thin films,

i.e., as thin as 0.0001 inch (2.54  $\mu$ m). However, Austen also points to disadvantages of such films, i.e., that these thinner films are “difficult to handle” and that “[s]pecial techniques and equipment are required...thereby increasing the costs of producing such film”.

Further, as indicated by the Examiner, Austen “...teaches a biaxially oriented film comprising a thermoplastic polymer...” which “...may further include **strengthening materials**” (emphasis added). Austen’s sheets are therefore characterized by tensile strength and impact strength, among others. Austen is not at all related to **easy** tear propagation of the film prepared therein. In fact, by adding strengthening materials to the films, Austen is teaching away from films that are easily torn, i.e., are weaker.

In fact, one of skill in the art would not have been motivated to employ materials that impart strength to a composition, such as the fibers of Austen, to form thinner films, since doing so would on result in a thick films that are difficult to tear.

Applicants’ films differ from the sheets of Austen since Applicants’ films are **thinner** and are characterized by **easy tearability**. Applicants’ film that is prepared by the combination of a thermoplastic polymer and specific fibers is not a stronger film, such as described by Austen. Instead, the fibers utilized in Applicants’ invention surprisingly assisted in the easier tearability of the film (see, page 6, line 26 through page 7, line 8 of Applicants’ specification). Applicants’ selection of the specific fibres enables production of a thin film with easy initial tearability. This characteristic of Applicants’ film is contrary to the teachings in the art that fibers are used to improve and increase mechanical stability of polymers.

As noted above, Austen therefore fails to supply both the required motivation and the reasonable expectation of success that thinner films could be prepared by his methods, which is required to render the present invention obvious.<sup>1</sup> Obtaining the

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<sup>1</sup> “Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under 35 USC § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success.” In re Vaack, 947 F. 2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)

motivation for combination of the prior art cannot properly be provided by the disclosure.<sup>2</sup>

The mere fact that this prior art may be modified in the manner as suggested by the Examiner does not make the modification obvious, unless the prior art suggested the desirability of the modification.<sup>3</sup> As discussed above, the prior art reference<sup>4</sup> does not suggest the claimed invention and in fact, teaches away from the same.

Nor does the combination of these references provide any *expectation of success* that if one were to attempt to obtain thinner films, that one would obtain the same that could be easily torn. The only source of the required motivation to make the films of Applicant's invention is provided by the Applicants' own specification. The only teachings that supply the necessary motivation and expectation of success that such a composition would be useful are provided by the instant specification. Obtaining the motivation for combination of the prior art cannot properly be provided by Applicants' own disclosure.

Applicants maintain that Austen fails to supply both clear and specific suggestions and evidence which provide both motivation *and a reasonable expectation of success* required to set forth obviousness of the pending claims.

Austen therefore effectively *teaches away* from Applicants' claimed invention and therefore does not teach or suggest the invention of claims 1, 17-25, and 27-30 of Applicants' invention.

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<sup>2</sup> "In re Oetiker, 977 Fd 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) "There must be some reasons, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the Appellant's invention itself."

<sup>3</sup> In re Fritch, 23 USPQ2d 1780, 1783-1784 (Fed. Cir. 1992), citing In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

<sup>4</sup> Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F. 2d 1044, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) "Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."

Reconsideration of the rejection of claims 1, 17-25, and 27-30 over Austen alone is requested.

Hatke does not add anything to Austen to teach or suggest Applicants' claim 26, i.e., a metallized film having easy initial tearability

Austen is discussed above.

Hatke teaches metallized polyolefin films and processes for producing the same. Hatke does not add anything to Austen to teach or suggest a polymer film less than 100  $\mu\text{m}$  in thickness and characterized by *easy tearability*. If Hatke is combined with Austen, metallized fabrics, molded articles and *thicker*, spherulite-containing, *strong* films are provided, but do not have *easy tearability*.

In view thereof, Austen in combination with Hatke does not teach or suggest claim 26 of Applicants' invention.

Reconsideration of this rejection is requested.

Itakura does not add anything to Austen to teach or suggest Applicants' claims 13-16, 31, and 32, i.e., a film having easy initial tearability

Austen is discussed above.

Itakura does not add anything to Austen to teach or suggest a polymer film less than 100  $\mu\text{m}$  in thickness and characterized by *easy tearability*. The whiskers utilized in Itakura impart elevated strength and elasticity to the resins discussed therein, and thereby *reduced* tearability of the resins. Further, the films of Itakura are 0.1 to 2 mm in thickness, which is far greater than the film thickness of Applicants' invention. If Itakura is combined with Austen, *strong, thick* resin compositions are provided, but do not have *easy tearability*.

In view thereof, Austen in combination with Itakura does not teach or suggest claims 13-16, 31, and 32 of Applicants' invention.

Reconsideration of this rejection is requested.

In view of the amendments and remarks above, Applicants submit that all rejections may be properly withdrawn and claims 1, 13-16, and 18-36 be allowed to proceed to issuance.

The Director is hereby authorized to charge any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees to our Deposit Account Number 08-3040.

Respectfully submitted,

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